

Application For Costs
In Trade Mark Application Nos. 29/02 & 990/00
By L. D. Waxson (s) Pte Ltd

And

Objection
By Tohtonku (s) Pte Ltd

Before Principal Assistant Registrar P Arul Selvamalar
24 April 2003

Interlocutory hearing – Opponents withdrew opposition after Applicants filed counter statement - whether Applicants entitled to cost of objecting to extensions of time to file notice of opposition and Opponents’ statutory declarations – whether Applicants entitled to cost of preparing evidence for Applicants’ statutory declaration

The Applicants, L D Waxson (S) Pte Ltd had 2 trade mark applications which were accepted for registration and advertised. The Opponents applied for an extension of time to file an opposition to the registration of the Applicants’ mark TMA 29/02. The Applicants objected to the grant of the extension of time and cited reasons why the extension of time should not be granted. The Registrar granted the extension of time without an interlocutory hearing. The Opponents filed their opposition within the extended deadline. In TMA 990/00 the Opponents filed their opposition within the 2 month deadline. The Applicants filed their counter statements in response to both oppositions. The Opponents then applied for extensions of time to file Statutory Declarations in support of the oppositions. Thereafter the Opponents withdrew the oppositions. The Applicants applied for costs, including the cost of objecting to the grant of the extensions of time and the cost of preparing evidence for the Applicants’ statutory declarations in support of the applications. The Applicants submitted that although interlocutory hearings were not fixed to determine whether the extensions of time should be granted, the Applicants’ correspondence objecting to the extensions formed part of the preparation for interlocutory proceedings and were recoverable under item 5 of the Scale of Costs in the Fourth Schedule. They also submitted that the cost of preparing evidence for the Applicants’ Statutory Declaration was recoverable under item 3 of the Scale of Costs.

Held,

- The heading Interlocutory Proceedings in the Scale of Costs in the Fourth Schedule and Item 5 which states “Preparing for all interlocutory proceedings”, is limited to interlocutory hearings which have been fixed by the Registrar. If parties have been informed by the Registrar that a hearing has been fixed to determine whether an extension of time should be granted, then the work done preparing for the hearing falls within the description. Correspondences to the Registry objecting to the application for extension of time do not fall within this heading. The Applicants’ claim for costs of \$120 each, for objecting to 3 applications for extensions of time by the Opponents, is denied in both oppositions.
- Item 3 in the Scale of Costs which states “Preparing and filing evidence for opposition proceedings”, is limited to instances where the evidence is filed with the Registry. If the evidence is not filed, the Registrar would not be able to assess the amount of work that was involved in the preparation of the evidence and whether the evidence was relevant. Therefore the claim for a sum of \$500 each for preparing evidence for the Applicants Statutory Declaration is denied in both oppositions. The cost of the survey evidence, a sum of \$6,489.00, claimed in TMA 990/00 is also denied for the same reasons.
- The Applicants also claimed a sum of \$100 for writing to the Registrar to seek an award of costs. The Scale only allows an award of costs for “Drawing bill of costs” and “Attending taxation proceedings and obtaining the Registrar’s certificate”. Therefore this claim is denied. The Applicants also claimed a sum of \$100 for photocopying, transport and courier charges without any explanation as to why these expenses were incurred. Therefore this claim is denied.
- The Applicants claimed a sum of \$120 which is the maximum of the range provided by the Scale for attending the taxation hearing. A distinction must be drawn between attending a taxation hearing at the end of a full opposition hearing and at a preliminary stage where an opposition is withdrawn. A sum of \$50 is awarded to

the Applicants for attending the taxation hearing and obtaining the Registrar's certificate as this taxation hearing relates to proceedings which ended at a very early stage.

- Costs awarded to the Applicants for each opposition are as follows:
 - Perusing Notice of Opposition (6 pages) \$ 12
 - Preparing & filing a counter statement \$120
 - Drawing bill of costs (4 pages) \$ 8
 - Attending taxation proceedings & obtaining certificate \$ 50
 - Disbursements:
 - Filing fee for counter statement \$325
- Cost of \$515 per opposition, a total sum of \$1030, is to be paid by the Opponents to the Applicants.

Legislation referred to:

- Trade Marks Rules 1998, Fourth Schedule, Scale of Costs

Representation:

- Ms Jimmy Yap (Ngaw Tan & Yap) for the Applicants
- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents